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10/612,471	07/02/2003	Ronald F. Watts	139102	3145
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RG and Associates 1103 Twin Creeks Allen, TX 75013				
EXAMINER				
ELAHEE, MD S				
ART UNIT		PAPER NUMBER		
2614				
NOTIFICATION DATE		DELIVERY MODE		
05/28/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/612,471

**Applicant(s)**

WATTS ET AL.

**Examiner**

MD S. ELAHEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/09/2009 has been entered.

### ***Response to Amendment***

2. This action is responsive to an amendment filed on 03/09/2009. Claims 1-20 are pending.

### ***Response to Arguments***

3. Applicant's arguments filed on 03/09/2009 Remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,460,658. Because claims in the co-pending application are broader than the ones in patent, *In re Van Ornum and Stang*, 214 USPQT61, broad claims in the co-pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application is the same as claim 1 of the patent except that receiving indications provided to the packet data network of at which of the first and at least second locations at which the user selects to communicate by way of the first telephonic network. Therefore, claim 1 of the pending application is broader than claim 1 of the patent.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-5, 12, 13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples et al. (U.S. Patent No. 5,889,845) in view of Cho (U.S. Pub. No. 2003/0165145).

Regarding claims 1 and 12, with respect to Figures 1-5, 12-20, Staples teaches in a communication network having at least a co-worker telephone instrument 122 in Fig.3 [i.e., first calling station] connected to a PBX 112 in Fig.3 [i.e., first telephonic network] and a service-user calling station connected to a network including virtual presence server 106 and corporate LAN 114 in Fig.3 [i.e., packet-based network] (col.5, lines 17-27, 37-47, col.7, lines 37-46), an improvement of an assembly for facilitating call connection between the first calling station and the service-user calling station, the service-user calling station having at least a first virtual calling-station identity in the first telephonic network such that the service-user calling station appears virtually resident in the first telephonic network (col.3, lines 31-40, col.10, lines 14-24), said assembly comprising:

a virtual-location indexer embodied at the packet-based network, said indexer for indexing remote user identification [i.e., first virtual calling-station identity of the service-user calling station] and security information (col.2, lines 55-60);

However, Staples does not specifically teach indexing together the at least the first virtual calling-station identity with a selected packet-based-network identity of the service-user calling station. In otherword, Staples does not specifically teach the first virtual calling-station identity of the service-user calling station corresponding a selected packet-based-network identity of the service-user calling station. Cho teaches the first virtual calling-station identity of the service-user calling station corresponding a selected packet-based-network identity of the service-user calling station (fig. 1; page 2, paragraph 0019, page 5, paragraph 0049). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Staples to incorporate the feature of the first virtual calling-station identity of the service-user calling station corresponding a selected packet-based-network identity of the service-user calling station in Staples's invention as taught by Cho. The motivation for the modification is to do so in order to connect a call over a data network from a circuit switch network without making any significant delay.

Staples further teaches the packet-based-network identity associated with logical connection of the service-user calling station to the packet data network and the virtual calling-station identity associated with a virtual residency location of the service-user calling station in the first telephonic network, and said indexer accessed pursuant to call routing of a call between the first calling station and the service-user calling station to permit effectuation of the call

connection therebetween, wherein the call connection is local to the first telephonic network (col.2, line 55-col.3, line 10, col.6, lines 39-48).

Regarding claim 2, Staples, as applied to claim 1, teaches that the service-user calling station is logically connectable to the packet data network at any of a corporate office [i.e., first logical location] and at least a home location [i.e., second logical location] and wherein the selected packet-based-network identity of the service-user calling station is associated with a selected one of the first logical location and the second logical location at which the service-user calling station is connected to the packet data network (fig.3; col.2, line 55-col.3, line 10).

Regarding claim 3, Staples, as applied to claim 2, teaches that the service-user calling station is moveable, separately connectable at the first logical location and at the at least the second logical location, and wherein the selected packet-based network identity indexed together by said virtual location indexer is updateable responsive to movement and connection of the service-user calling station separately at the first logical location and at the at least the second logical location (col.2, line 55-col.3, line 10, lines 31-40).

However, Staples in view of Cho does not specifically teach whether the index is updateable. Examiner takes official notice that updating index is well known in the art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Staples in view of Cho to incorporate the feature of updating an index in Staples's invention in view of Cho's invention in order to keep the index updated such that any calls

routed for an intended remote access user can easily be routed to his current location based on the updated information.

Regarding claim 4, Staples, as applied to claim 1, teaches that the packet data network comprises a presence server [i.e., proxy server] and wherein said virtual location indexer is embodied at the proxy server (fig.3; col.2, line 55-col.3, line 10).

Regarding claim 5, Staples, as applied to claim 1, teaches that the packet-based-network identity of the service-user calling station indexed by said virtual location indexer comprises an IP-address (fig.3; col.2, line 55-col.3, line 10).

Regarding claim 13, Staples, as applied to claim 12, teaches that the operation of initiating a call by the first communication station to the service-user calling station through entry of indicia of a selected one of the at least the first calling-station identity (col.2, line 55-col.3, line 10).

Claim 16 is rejected for the same reasons as discussed above with respect to claim 3. Furthermore, Staples, as applied to claim 12, teaches that the service-user calling station is logically connectable to the packet data network at any of a first logical location and at least a second logical location and wherein said method further comprises the index formed during said operation of indexing when the service-user calling station is reconnected out of one of the first



and at least second logical locations and connected into another one of the first and at least second logical locations (col.2, line 55-col.3, line 10, lines 31-40).

Regarding claim 17, Staples, as applied to claim 16, teaches that the packet data network comprises a proxy server and wherein the index formed during said operation of indexing is embodied at the proxy server (col.2, line 55-col.3, line 10, lines 31-40).

Regarding claim 18, Staples, as applied to claim 12, teaches that the at least the first virtual calling station identity comprises the first calling station identity and at least a second virtual calling station identity and wherein the index formed during said operation of indexing indexes all of the first and at least second virtual calling stations together with the selected packet-based network identity (col.2, line 55-col.3, line 10, lines 31-40).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Staples et al. in view of Cho further in view of Singh et al. (U.S. Pub. No. 2007/0274474).

Regarding claim 6, Staples, as applied to claim 5, teaches that the service-user calling station operates pursuant to an SIP (session initiation protocol) and wherein the packet-based-network identity of the service-user calling station indexed by said virtual location indexer comprises a SIP IP-address (col.2, line 55-col.3, line 10, lines 31-40).

However, Staples in view of Cho does not specifically teach operating pursuant to an SIP (session initiation protocol) and indexer comprising a SIP IP-address. Singh teaches that

operating pursuant to an SIP (session initiation protocol) and indexer comprising a SIP IP-address (page 2, paragraph 0025). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Staples in view of Cho to incorporate the feature of operating pursuant to an SIP (session initiation protocol) and indexer comprising a SIP IP-address in Staples's invention in view of Cho's invention as taught by Singh. The motivation for the modification is to do so in order to establish an internet session using a SIP protocol such that users can get benefit from unified messaging services on a SIP based system.

10. Claims 7-10, 14, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples in view of Cho further in view of Koch et al. (U.S. Pub. No. 2004/0234061).

Regarding claims 7 and 14, Staples, as applied to claims 1 and 13, teaches that the packet-based-network further comprises a presence server that couples the first telephonic network together with the packet-based network wherein a call to the service-user calling station by the first calling station is routed to the presence server and wherein said presence server accesses said virtual location indexer to obtain the selected packet-based network identity of the service-user calling station to route the call thereto (fig.3; col.2, line 55-col.3, line 10).

However, Staples in view of Cho does not specifically teach that the packet-based-network further comprises a gateway, wherein a call is routed to the gateway and wherein said gateway accesses said virtual location indexer. Koch teaches that the packet-based-network further comprises a gateway, wherein a call is routed to the gateway and wherein said gateway accesses said virtual location indexer (fig.8; page 8, paragraph 0106). Thus, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify Staples in view of Cho to incorporate the gateway in Staples's invention in view of Cho's invention as taught by Koch for accessing the virtual location indexer and routing a call. The motivation for the modification is to do so in order to access a database through the gateway such that routing a call from telephony network to internet based network can be achieved.

Regarding claims 8, 15 and 20, Staples in view of Cho, as applied to claims 7, 14 and 19, does not specifically teach that the first telephonic network comprises a service control point, wherein the gateway is identified by a gateway address, wherein the call to the service-user calling station by the first calling station is caused to be routed by the service control point to the gateway. Koch teaches the first telephonic network comprises a service control point, wherein the gateway is identified by a gateway address, wherein the call to the service-user calling station by the first calling station is caused to be routed by the service control point to the gateway (fig.8; page 8, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Staples in view of Cho to incorporate the feature of the first telephonic network comprising a service control point, wherein the gateway is identified by a gateway address, wherein the call to the service-user calling station by the first calling station is caused to be routed by the service control point to the gateway in Staples's invention in view of Cho's invention as taught by Koch. The motivation for the modification is to do so in order to process a call by determining routing information to route the call.

Regarding claims 9 and 19, Staples, as applied to claims 8 and 17, teaches that the call to the service-user calling station is initiated by the first calling station through entry thereof of the first virtual calling-station identity and wherein the assembly further comprises a database (col.2, line 55-col.3, line 10).

However, Staples in view of Cho does not specifically teach that a database embodied at the service control point, the database comprising a map that maps the first virtual calling-station identity together with the gateway address. Koch teaches that a database embodied at the service control point, the database comprising a map that maps the first virtual calling-station identity together with the gateway address (fig.8; page 8, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Staples in view of Cho to incorporate a database embodied at the service control point, the database comprising a map that maps the first virtual calling-station identity together with the gateway address in Staples's invention in view of Cho's invention as taught by Koch. The motivation for the modification is to do so in order to determine routing information to route a call.

Regarding claim 10, Staples, as applied to claim 9, teaches that the at least the first virtual calling-station identity of the service-user calling station comprises the first virtual calling-station identity and at least a second virtual calling-station identity (col.2, line 55-col.3, line 10).

However, Staples in view of Cho does not specifically teach that the map formed of said database maps all of the first and at least second calling-station identities of the service-user calling station together with the gateway address. Koch teaches that the map formed of said database maps all of the first and at least second calling-station identities of the service-user

calling station together with the gateway address (fig.8; page 8, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Staples in view of Cho to incorporate the map formed of said database maps all of the first and at least second calling-station identities of the service-user calling station together with the gateway address in Staples's invention in view of Cho's invention as taught by Koch. The motivation for the modification is to do so in order to determine routing information to route a call from a caller to a called party.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Staples et al. in view of Cho further in view of Himbeault et al. (U.S. Patent No. 6,711,155).

Regarding claim 11, Staples, as applied to claim 1, teaches that the first telephonic network comprises a PBX switch and wherein a call placed by the first calling station to the service-user calling station is routed by the PBX switch to the packet data network and wherein, once delivered to the packet data network, the selected packet-based-network identity indexed together at said virtual location indexer is determined, and the call is routed thereto (col.2, line 55-col.3, line 10, lines 31-40).

However, Staples in view of Cho does not specifically teach that the first telephonic network comprises a TDM (time division multiplexed) network having a TDM switch. Himbeault teaches that the first telephonic network comprises a TDM (time division multiplexed) network having a TDM switch (abstract; col.1, lines 38-47, col.2, lines 16-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was

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made to modify Staples in view of Cho to incorporate a TDM (time division multiplexed) network having a TDM switch in the first telephonic network in Staples's invention in view of Cho's invention as taught by Himbeault. The motivation for the modification is to do so in order to carry timing information for achieving synchronization.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/MD S ELAHEE/  
MD SHAFIUL ALAM ELAHEE  
Primary Examiner  
Art Unit 2614  
May 26, 2009